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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,070	03/19/2004	Masakazu Sueda	D-1607	7044

7590 05/02/2006

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EXAMINER

PATEL, VISHAL A

ART UNIT PAPER NUMBER

3673

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/804,070	SUEDA, MASAKAZU	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vishal Patel	3673	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2006 and 31 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,6,14,16 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6,14,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/7/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

The election was made by original presentation to figures 3-4, therefore no election/restriction was sent. Applicant has elected claims 1, 6, 14, 19 and 20. Claims that are withdrawn are 16 and 21-23.

Applicants' argument that in the original presented claims there was a generic claim is incorrect because the claims were directed to having a main bead (where a bead has two half beads). Now applicant has claimed particulars that are in figures 7-11 in claims 16 and 21-23, where there is a half bead. This is the reason that a non-responsive was sent to the applicant. This restriction is made final.

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "at least one of the first and second outer sub-bead sections is formed intermittently in a circumferential direction" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

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drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6, "circumferential direction", unclear to what circumferential direction is represented from (circumferential direction around hole or gasket or main bead or etc).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue (JP 09229198A).

Inoue discloses a metal gasket having a hole to be sealed (figure 6). The metal gasket having a first metal base plate (top plate 1) having one first main bead (main bead on either side of 3) around the hole, a first outer sub-bead section smaller (one of sub bead 5) than the first

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main bead and provided outside the first main bead, a first inner sub-bead section (other sub bead 5) smaller than the first main bead and provided inside the first main bead, a second metal base plate (bottom plate 2) laminated with the first metal base plate and having one second main bead (main bead on either side of 4) around the hole, a second outer sub-bead section (one of sub bead 6) smaller than the second main bead and provided outside the second main bead, the second outer sub-bead section abutting at least partly against the first outer sub-bead section in a radial direction of the hole for sealing (the beads 5 and 6 abut in a radial direction), a second inner sub-bead section (other sub bead 6) smaller than the second main bead and provided inside the main bead, the second inner sub-bead section abutting at least partly against the first inner sub-bead section in the radial direction for sealing (beads 5-6 abut in the radial direction) and the first and second main beads are arranged to project opposite of each other (the first main bead projects outwardly and the second main bead projects opposite the first main bead).

The first and second outer sub-beads sections orient in same directions so that one of the first and second outer sub-bead sections fit in the other of the first and second outer sub-bead section (the beads 5 fits into beads 6).

At least one of the first and second sub-bead sections is formed intermittently in a circumferential direction (that is the case, the sub-bead is not continuous in a circumferential direction of the hole).

The first and second inner sub-bead sections contact each other and the first and second outer sub-bead sections contact each other when the gasket is assembled (figures 6 and 8).

The second outer sub-bead section is at least partly located outside the first outer sub-bead section and the second inner sub-bead section is at least partly located inside the first inner

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sub-bead section so that when the gasket is compressed, the second outer and inner sub-bead sections restrict lateral movements of the first outer and inner sub-bead section (this is the case since sub-beads 5 are received into sub-beads 6).

The second main bead has a size less than that of the first main bead (this is the case since as seen in figure 8, a second main bead 3 is placed into a first main bead 4, sub-beads 5 and sub-beads 6).

5. Claims 1, 14 and 20 rejected under 35 U.S.C. 102(b) as being anticipated by Nicholson (US. 4,387,904). See attached figure 3.

Nicholson discloses a gasket having a first plate (top plate of figure 3, see attached figure) having a first main bead projecting outwardly and around a hole, a first inner sub bead and a first outer sub bead on opposite sides of the main bead, a second plate having a second main bead around the hole, the second plate having a second inner sub bead and a second outer sub bead, the inner and outer sub beads fit into each other (see attached figure). The second main bead having a size that is smaller than the first main bead. The sub beads restrict lateral movements of the plates. The thicknesses of the first and second plates are different.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue.

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Inoue discloses the invention substantially as claimed above but fails to disclose that the first and second outer and inner sub-bead sections have a trapezoidal shape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to change the shape of the sub bead sections to have a trapezoidal shape to provide mechanical expedience.

Furthermore evidence is shown by Yamada (US. 5,725,223) to have beads in the form of a semi-circle (figure 5) or trapezoidal (figure 4)

***Response to Arguments***

8. Applicant's arguments filed 3/2/06 and 10/31/05 have been fully considered but they are not persuasive.

Applicants' arguments to beads 3 and 4 of the Inoue contact is not persuasive because the first main bead is adjacent to 3 and the second main bead is adjacent to 4 and they do not contact each other and are projection oppositely from each other.

Applicants' argument that the sub-bead sections do not entirely sandwich each other is not persuasive because this is clearly taught by Inoue.

9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the second outer and inner sub-bead sections is greater than that between the first and second inner sub-bead sections") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants' arguments to non-elected claims are moot.

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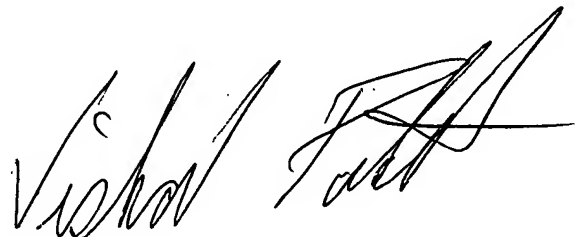
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia L. Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP  
April 27, 2006

A handwritten signature in black ink, appearing to read 'Vishal Patel', with a stylized flourish at the end.

Vishal Patel  
Patent Examiner  
Tech. Center 3600



, 1983

4,387,904

